Mailed:
August 12, 2003

Paper No. 21
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Valspar Corporation

Serial No. 75/439,331

John A. Clifford and Kristina M. Foudray of Merchant & Gould P.C. for The Valspar Corporation.

Barney L. Charlon, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Simms, Hairston and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

The Valspar Corporation has filed an application to register GREAT COAT as a mark for "interior and exterior paints, and interior and exterior stains," asserting a bona fide intention to use the mark in commerce for such goods. Registration is sought on the Principal Register. During examination, applicant voluntarily offered, and the examining attorney accepted and entered, a disclaimer of exclusive rights to the word COAT.

Registration has been refused by the examining attorney, on the ground that the term GREAT COAT combines a laudatory term, GREAT, with a descriptive term, COAT, and that the composite is, therefore, barred from registration because of Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1). When the refusal was made final, applicant appealed. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal of registration.

The examining attorney, in support of the refusal of registration, has provided dictionary definitions of "great" and of "coat." The former word is defined as meaning, among other things, "remarkable or outstanding in magnitude, degree or extent," and "superior in quality or character; noble." The latter word is defined to mean "a layer of material coating something else; a coating: *a second coat of paint*." Also offered in support of the refusal of registration are third-party registrations that show marks with one of the two words and a disclaimer of that word, or marks with one of the two words and that have been registered only on the Supplemental Register or on the Principal Register upon a showing of acquired distinctiveness. Finally, the examining attorney has submitted two excerpts from the NEXIS database of articles

and other news reports, and reprints of pages from three websites. One of the NEXIS excerpts and two of the web sites use the term "great coat" in references to paint jobs completed on houses. The other NEXIS excerpt uses the term "great coats" in referencing nail polish and manicures; the third web site uses the term "great coat" in describing the paint job of a collectible die-cast model car.

Applicant has attempted to counter the examining attorney's submissions by pointing to third-party registrations that show marks including the word GREAT have been registered on the Principal Register without a disclaimer of that word and without resort to Section 2(f) of the Lanham Act.[1] For example, it appears GREAT FINISHES has been registered on the Principal Register for "exterior and interior paints, paint primers, wood stains, lacquers in the nature of coatings, and varnishes."[2] As applicant has disclaimed exclusive rights in the COAT portion of its mark, there does not appear to be any dispute that "coat" is a descriptive term when used on or in connection with paints and stains; thus, we need not discuss either the

[1] Applicant's submissions are not copies of the registration certificates; nor are they reprints from the Office's electronic database of registered and pending marks. Rather they are copies from a private company's database.

[2] Registration no. 2,019,696, issued November 26, 1996.

examining attorney's or applicant's submissions (the latter made prior to applicant's submission of a disclaimer of COAT) regarding the proper characterization of that word.

Applicant argues that the composite GREAT COAT is merely suggestive for its goods. Noting that the identical mark has previously been registered for "paints" (a registration that has since expired), applicant argues that this is significant evidence that the Office considers the composite to be merely suggestive, not descriptive. Applicant also argues that it was unable to discover any registrations in international class 2 for marks including the word GREAT, wherein that word was the subject of a disclaimer. Finally, applicant argues that it was "unable to find any case that has determined whether the use of the term 'GREAT' in a trademark is laudatory, descriptive, or suggestive,"[3] so that the Office's "past handling of the

[3] Applicant does rely on In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995), which dealt with an attempt to register SUPER BUY, as stating or suggesting that GREAT BUY would be considered suggestive, in contrast with the involved mark SUPER BUY. On the other hand, the examining attorney relies on Popular Bank v. Banco Popular, 9 F.Supp.2d 1347 (S.D.Fla. 1998) and its citation to Great S. Bank v. First S. Bank, 30 USPQ2d 1522 (Sup. Ct. Fla. 1993), for the proposition that "great" is a laudatory descriptive term.

Each (applicant and the examining attorney) has criticized the other's reliance on the case law it has cited. We agree that these decisions deal with the question of the characterization of "great" only in dicta. Nonetheless, when fairly read, they tend to provide more support for the conclusion that "great" is laudatory rather than suggestive.

term GREAT in other marks for paint products is particularly relevant."

We admit that inconsistent Office handling of applications to register marks that include the word GREAT is troubling. Nonetheless, the Board is duty-bound to decide each case based on the record before it, without regard to whether other marks have correctly or incorrectly been registered. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("the Board … must assess each mark on the record of public perception submitted with the application"). Thus, we focus on the dictionary definitions, the one relevant NEXIS excerpt, and the three website entries in the record for what they reveal about likely public perception, more than we focus on the third-party registration submissions.

> A mark is merely descriptive if it immediately conveys qualities or characteristics of the goods. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). However, if a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods, then the mark is suggestive. Id. A suggestive mark qualifies for registration without secondary meaning. Id. The perception of the relevant purchasing public sets the standard for determining descriptiveness. In re Bed & Breakfast Registry, 791 F.2d 157, 160, 229 USPQ 818, 819 (Fed. Cir. 1986).
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> In re Nett Designs Inc., 57 USPQ2d at 1566.

As the Federal Circuit has noted, a term may possess both elements of descriptiveness and suggestiveness. *Id.* As with the word ULTIMATE in the *Nett Designs* decision, the word GREAT may be considered suggestive insofar as it "does not define any particular characteristic" of applicant's product, but "also has some elements of descriptiveness because it has a laudatory or puffing connotation." *Id.*

We think it beyond dispute that, as proposed for use on or in connection with paints, GREAT has a clearly laudatory connotation. It does not take on a double entendre or have its meaning altered when coupled with the admittedly descriptive word COAT. As the NEXIS and web site evidence reveals, applied paint may be said to be a "great coat of paint" and such phrase has a clearly laudatory meaning that it takes no imagination to discern. Likewise, even when the phrase is shortened to GREAT COAT, it is immediately clear that the connotation of that term, when used on or in connection with paint, indicates that the purchaser will get a "great coat of paint" from the product.

Any paint manufacturer should be left free to tout its products as providing a "great coat" upon application. Moreover, we note that while the record is rather thin, we do not require the same type of record as would be required

if the refusal of registration were based on a conclusion that GREAT COAT was generic and therefore to be removed from any possible use as a mark. Because the refusal is based on the ground of descriptiveness, and GREAT COAT may still be registered in the future on a showing of acquired distinctiveness, we do not require as great an evidentiary showing as if the refusal were on the ground of genericness. Cf. In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), wherein the Federal Circuit held that more than mere evidence of the genericness of component parts of a mark would be required when a composite phrase is to be refused as generic.

We find that GREAT COAT, if used on or in connection with paints and stains, would immediately be perceived as a laudatory description of the products as providing a great coat of paint or stain and, accordingly, is properly refused registration as descriptive.

Decision: The refusal under Section 2(e)(1) of the Lanham Act is affirmed.